REMARKS

This application has been reviewed in light of the Final Office Action dated March 17, 2006. Claims 1-19 are pending, with Claims 1, 6, 11, and 16 in independent form. No changes to the claims have been made by this Response. Favorable reconsideration is respectfully requested.

Claims 1-19 were rejected under 35 U.S.C. §112, first paragraph, as allegedly failing to comply with the written description requirement. Claims 1-3, 5-8, 10-13, and 15-18 were rejected under 35 U.S.C. §102(b) as allegedly anticipated by U.S. Patent No. 5,337,161 (Hube). Claims 4, 9, 14, and 19 were rejected under 35 U.S.C. §103(a) as allegedly unpatentable over Hube in view of U.S. Patent No. 6,052,198 (Neuhard, et al.).

Applicants note that it appears that the amended claims submitted with Applicants' Amendment dated December 19, 2005 have not been substantively examined. In particular, the present Final Office Action duplicates the substantive Section 102(b) and Section 103(a) rejections from the previous Office Action dated September 19, 2005, without considering Applicants' amended claims or responding to their remarks distinguishing such claims from the cited references. The present Final Office Action includes only a new rejection under Section 112, first paragraph. However, in accordance with MPEP § 2143.03, Applicants respectfully submit that the claims should still have been substantively examined even in light of the Section 112, first paragraph rejections. Accordingly, Applicants respectfully request the issuance of a new Office Action with a reset time for response that includes a substantive examination of the amended claims provided with Applicants' Amendment dated December 19, 2005. In the event that this request is denied, this paper should be considered a Petition to the Director's Supervisory Authority for the issuance of a new Office Action including a substantive examination of Applicants' claims included in their December 19, 2005 Amendment. The Commissioner is authorized to charge any fees associated with such a Petition to Deposit Account No. 05-0225. A duplicate of this paper is included herewith.

In regard to the rejections under Section 112, first paragraph, Applicants respectfully traverse these rejections for at least the following reasons.

As noted in the Office Action at page 2, paragraph no. 4, §112, first paragraph, has been interpreted to require that the specification describe the

claimed subject matter in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the Application was filed, had possession of the claimed invention. See MPEP § 2163.02 (citations omitted). MPEP §2163.05 notes that "to comply with the written description requirement ... each claim limitation must be expressly, implicitly, or inherently supported in the originally filed disclosure." However, the specification need not provide literal support for the exact terminology used in the claims. See MPEP §2163(I)(B). See also MPEP §2163.02. Additionally, MPEP §2163.04(I) notes that the burden of establishing that claims do not provide support under 35 U.S.C. §112, first paragraph, rests on the Examiner. Part of this burden is the establishment of a *prima face* case by providing reasons why a person skilled in the art at the time the Application was filed would not have recognized that the inventor was in possession of the invention as claimed in view of the disclosure of the Application as filed. In the case of amended claims, a simple statement such as 'Applicant has not pointed out where the new (or amended) claim is supported, nor does there appear to be a written description of the claim limitation X in the Application as filed' is insufficient when the Applicant has pointed out where limitation X has been supported. See MPEP §2163.04(I).

Independent Claim 1 requires a printing system for printing a document. The printing system includes a job preparation station, including a processor, a memory, and a user interface. The job preparation station is configured at least to generate flags stored in the memory for each of a plurality of pages in a document to be printed. The flags are generated in response to first inputs received from the user interface. The first inputs specify that selected pages in the document include tabs, and the flags indicate that the selected pages in the document contain the tabs. The job preparation station also is configured to store specified characters for each of the selected pages to be rendered on the tabs. The specified characters for each of the selected pages are stored in the memory in a non-image format and are stored in response to second inputs received from the user interface. Additionally, the job preparation station is configured to store, on a plurality-of-page basis, global tab stock data in the memory identifying the tab stock to be used for printing all of the selected pages. The global tab stock data is stored in response to a third input received from the user interface. The printing system also includes a print output module that receives the flags,

specified characters to be rendered on the tabs, and the global tab stock data from the job preparation station and prints the specified characters on the tabs of the specified pages of the identified tab stock.

Support for Claim 1 can be found in the specification at least at page 22, line 7 to page 23, line 14. In particular, this portion of the specification states, in part,

> To allow for the flexibility of printing the tab contents on any one of the tab pages of an ordered tab set, the tab content in the present invention is not stored as a regular page of a document. According to the present invention, a flag or marker that indicates that a page contains a tab is stored in memory . . . . Preferably, the user uses a graphic user interface at a station such as the job preparation station 116 to input the marker or flag up front in the page or job creating stage.

Page 22, lines 7-14. Applicants respectfully submit that at least this description provides support for the clause in Claim 1 pertaining to generating flags stored in memory for each of a plurality of pages in a document to be printed, the flags being generated in response to first inputs received from the user interface, the first input specifying that selected pages in the document include tabs, the flags indicating that the selected pages in the document contain the tabs. In particular, page 22, lines 9-10 indicate that a flag that indicates that a page contains a tab is stored in memory. In order to store a flag in memory, it must be generated. Further, page 22, lines 12-14 indicate that a user via a user interface inputs the marker or flags. Accordingly, it can be said that the flags are generated in response to inputs received from a user interface. Although the label "first" is not literally used in the description to modify "input", 35 U.S.C. §112, first paragraph, includes no such requirement. See, e.g., MPEP §§ 2163(I)(B); 2163.02.

Page 23, lines 1-4 of the specification state that "using a utility that works with the same application used to assemble the input, the tab label information is entered independent from the tab order. This will normally include the text and font. This information is stored with the document." Applicants respectfully submit that at least this portion of the specification provides support

for the limitation in Claim 1 pertaining to storing specified characters for each of the selected pages to be rendered on the tabs, the specified characters for each of the selected pages being stored in the memory in a non-image format and being stored in response to second inputs received from the user interface. To elaborate, the "tab label information", which is described to normally include text and font, is respectfully submitted to provide support for specified characters to be rendered on the tabs. Further, the representing of the tab label information as text and font is submitted to provide support for the storing of specified characters in a non-image format. Further, the inputting of tab label information via an application accessible to a user provides support for the storing of specified characters in response to inputs received from a user interface. To the extent that the Office Action implies that the specific exact phrases "second inputs" and "non-image format" must be in the specification to provide support under Section 112, first paragraph, Applicants respectfully disagree and submit that Section 112, first paragraph includes no such requirement. See, e.g., MPEP §§ 2163(I)(B); 2163.02.

The specification at page 23, lines 5-6 describes that "the user then invokes the print output module and identifies the specific stock to use for the tabs. This identifies the order for the tabs." Applicants respectfully submit that at least this portion of the specification provides support for the feature of Claim 1 pertaining to global tab stock data being stored in response to a third input received from the user interface. Applicants respectfully submit that one skilled in the art, knowing that a user invokes a print output module and identifies specific stock to use for the tabs, would know that such tab stock data is stored in response to an input received from a user interface. Such input is different from the inputting of specified characters and the inputting of the flags, and, consequently, is properly titled a third input, to be distinguished from the second input and the first input recited in Claim 1.

Regarding Claim 1's use of the term "global" as a modifier of "tab stock data," page 22, lines 14-15 of the specification describes that the invention enables a user to move a page around in a document or even copy it to a different document without loosing tab information. Specific tab stock to be used when printing a document is not identified until the print output module is invoked. See page 23, lines 5-6. The tab stock data identifies, inter alia, the ordering of the

tabs. Consequently, Applicants submit that one skilled in the art would understand that such tab stock data is stored "globally," that is, stored on a plurality-of-page basis, as recited in Claim 1, in order to maintain the described advantage of the present invention of facilitating the movement of a page around in a document or even copy it to a different document. If the tab stock data were not stored on a plurality-of-page basis, the tab stock data associated with each page of a document would have to be updated to account for the change.

In view of the above, Applicants respectfully submit that support has been provided for the first five bullets under paragraph no. 4 of page 2 of the Office Action. The first bullet on page 3 of the Office Action pertains to receiving the specified characters to be rendered on the tabs in the global tab stock data from the job preparation station and printing the specified characters on the tabs of the selected pages. The specification states that preferably, the user uses a graphic user interface at a station such as the job preparation station 116 to input the marker or flag up front in the page or job creating stage. See page 22, lines 12-14. The specification also states that the tab label information is entered independent from the tab order. This will normally include the text and font. See page 23, lines 1-4. Additionally, the specification states that "the user then invokes the print output module and identifies the specific tab stock to use for the tabs." See page 23, lines 5-6. Accordingly, the specification describes that flags are input, specified characters (e.g. tab label information), and tab stock information are input from a user. Because these data are input via a user interface, it can be said that a job preparation station, including a user interface, is used to receive this data, such data being transmitted to a print output module. Applicants respectfully submit that one skilled in the art knowing that this data ultimately needs to be printed must in fact be output from the job preparation station to an output module for printing.

The Office Action at page 3 also specifies that there is allegedly no support for a first memory region, a second memory region, a third memory region. Applicants respectfully submit that the specification's disclosure of storing a flag in memory at page 22, lines 9-10 the storing of tab label information at pages 23, line 4, and then the subsequent inputting of specific tab stock information, communicates to one skilled in the art that all such data must be stored in memory. In particular, inputting and transmission of date requires the

storing of such data in memory somewhere along the communication path. Further, Applicants respectfully submit that any memory may be defined as having memory regions. To the extent that the Office Action implies that the specification needs to explicitly use the exact words "first," "second," and "third," as well as the word "region," Applicants respectfully reiterate that Section 112, first paragraph includes no such requirement. See, e.g., MPEP §§ 2163(I)(B); 2163.02.

For at least the above reasons, Applicants respectfully submit that one skilled in the art would appreciate that the inventors had possession of all of the features recited in Claim 1 based upon the application as filed. (It should be noted, however, that the scope of Claim 1 is not limited to the details of the embodiments described above, which are referred to for purposes of illustration only.)

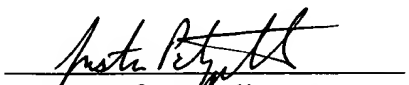
The other claims in this application include the same or similar features to those described above, and are respectfully submitted to be supported by the specification as filed for at least the same reasons.

In regard to the rejections of the claims under Section 102 and Section 103, Applicants reiterate the remarks made in their Amendment dated December 19, 2005.

This Response After Final Action is believed to place this application in condition for allowance and, therefore, its entry is believed proper under 37 C.F.R. § 1.116. Accordingly, entry of this Response After Final Action, as an earnest effort to advance prosecution and reduce the number of issues, is respectfully requested. Should the Examiner believe that issues remain outstanding, it is respectfully requested that the Examiner contact Applicants' undersigned attorney in an effort to resolve such issues and advance the case to issue.

In view of the foregoing remarks, Applicants respectfully request favorable reconsideration and the allowance of the present application.

Respectfully submitted,



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